

## Remarks

Claims 1-31 are pending in the application and are presented for the Examiner's review and consideration. Claims 12-18 have been withdrawn and claims 1, 8, and 26 have been amended. Applicant believes the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

### 35 U.S.C. 102 Rejections

Claims 1, 2, 4, 6-10, 19-20, 22, 24-29, and 31 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,417,701 to Holmes ("Holmes"). In response, Applicant respectfully submits that these rejections should be withdrawn.

Holmes discloses a suturing instrument that uses a magnet to properly position, orient and hold a needle within its jaws. (Col. 1, lns. 65-67). The magnet is embedded in one of the jaws and when the jaws are near the needle, the magnet attracts the needle to it, causing the needle to move to a predetermined position on the jaw containing the magnet. (Col. 1, ln. 67- col. 2, ln. 3). The surgeon may then have to push the needle across the magnet, to further expose the sharpened end of the needle. (Col. 2, lns. 3-5).

With the needle in the desired position and orientation, the surgeon manipulates the instrument to insert the needle into, and part way through the tissue to be sutured. (Col. 2, lns. 8-10). To perform a suturing procedure, a surgeon grasps a needle 32 with the suturing instrument 10, and guides the needle, which is properly positioned within the jaws 14 by the magnet 36, through the tissue. (Col. 4, lns 18-21).

She then uses a second, similar instrument to grasp the needle and pull it the rest of the way through the tissue. (Col. 2, lns. 12-14). When this second instrument pulls the needle out of the tissue, the included magnet draws the needle into proper position within its jaws and holds the needle in this position until the needle is transferred to the first instrument. (Col. 2, lns. 16-20).

To transfer the needle, the two instruments are brought together, both sets of jaws are opened, and because of the greater strength of the magnet in the first instrument, the needle moves from its position in the second set of jaws to its previous position in the first set of jaws. (Col. 2, lns. 19-24). The surgeon then re-grasps the needle by closing the jaws of the first instrument around it, pushes the needle across the magnet, as necessary, to further expose the sharpened end, and continues the suturing procedure. (Col. 2, lns. 24-29).

As such, Holmes discloses an instrument which grasps a needle between two jaws for insertion of the needle through the tissue. The needle remains grasped by the jaw when it is inserted into the tissue. A second instrument can be used to grasp the needle on the opposite side of the tissue, pulling the needle completely through the tissue.

The jaws can include magnets, which are only disclosed as being intended to hold the position of the needle in the jaws when the jaws are opened. The magnet aligns the needle on the jaws, such that when the jaws are closed, grasping the needle, the needle is properly aligned in the jaws.

However, Holmes fails to disclose that the magnet on the jaws generates a magnetic field of sufficient strength to move the medical implement through the tissue. As disclosed, the needle is grasped in the jaws when the needle is pushed through the tissue. The tip of the needle is then grasped by the jaws to pull the needle the rest of the way through the tissue. There is no disclosure that the needle is moved through the tissues by the magnet. Furthermore, it would not be possible for the magnet to move the needle through the tissue, as the needle is grasped by, fixed between, the jaws when the needle is pushed and pulled through the tissue.

Claims 1 recites, *inter alia*, an apparatus for moving a medical implement having a magnetic component through a tissue in a patient. The apparatus includes a magnetic field generator generating a magnetic field of sufficient strength to move the medical implement through the tissue free of assistance from mechanical force. Claims 8 and 26 include similar elements.

As noted above, the Holmes device does not disclose a magnet generating a magnetic field of sufficient strength to move the medical implement through the tissue. In Holmes the medical

medical implement, i.e. needle, is pushed and pulled through the tissue by the application of a force from the medical instrument, while the needle is grasped in the jaws of the medical instrument,

In light of the foregoing, Applicant submits that claims 1, 8, and 26 are patentable over Holmes. As claims 1, 2, 4, 6, and 7 depend from claim 1, and claims 9, 10, 19-20, 22, 24, and 25 depend from claim 8, and claims 29 and 31 depend from claim 26, including all of the recitations thereof, Applicant submits that these dependent claims are patentable at least for the same reasons.

#### 35 U.S.C. 103 Rejections

Claims 3, 5, 11, 21, 23, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Holmes in view of U.S. Patent No. 5,851,185 to Burns ("Burns"). Claims 1, 8, and 26 are submitted to be patentable over Holmes. Applicant further submits that the inclusion of Burns fails to overcome the deficiencies of Holmes. As claims 3 and 5 depend from claim 1, claims 11, 21, and 23 depend from claim 8, and claim 30 depends from claim 26, these claims are submitted to be patentable over the cited art at least for the same reasons.

#### Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Applicant: P. Bonutti  
Application No.: 10/784,401  
Examiner: M. Andersen

No fee is believed due. However, please charge any fees (or credit any overpayment of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A04-02-1).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. D. Bianco', with a horizontal line extending to the right.

Paul D. Bianco, Reg. # 43,500

Customer Number: 33771  
Paul D. Bianco  
FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO  
21355 East Dixie Highway, Suite 115  
Miami, Florida 33180  
Tel: 305-830-2600; Fax: 305-830-2605  
e-mail: [pbianco@focusonip.com](mailto:pbianco@focusonip.com)